

## REMARKS

This is intended as a full and complete response to the Office Action dated March 15, 2010, having a shortened statutory period for response set to expire on June 15, 2010. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-20 are pending in the application. Claims 1-20 remain pending following entry of this response. Claim 1 has been amended. Applicant submits that the amendments and new claims do not introduce new matter.

Further, Applicant does not concede that any pre-amended or canceled claim is not patentable over the art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the claimed subject matter. Applicant respectfully reserves the right to pursue any pre-amended or canceled claim (as well as other claims) in one or more continuations and/or divisional patent applications.

### STATEMENT OF COMMON OWNERSHIP

The present application (Serial No. 10/824,055; hereinafter the "Application") and United States Patent Application Publication No. US 2005/0102676 (*Forrester*), were, at the time the invention of the Application was made, owned by the same entity, or subject to an obligation of assignment to the same entity.

*Forrester* was filed on November 6, 2003, but not published until May 12, 2005, after the April 14, 2004 filing date of the present application. Thus, *Forrester* is available as prior art only under 35 U.S.C. § 102(e). However, in light of the statement of common ownership above, *Forrester* is disqualified under 35 U.S.C. § 103(c) as a references available for making a rejection under 35 U.S.C. § 103.

### Claim Rejections - 35 U.S.C. § 102

Claims 1-11 rejected under 35 U.S.C. 102(e) as being anticipated by *Serkin et al.*, U.S. Patent Application Publication 2003/0229567 (see PTO-892, Ref. A) (hereinafter *Serkin*). Applicant respectfully traverses this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Serkin* does not disclose "each and every element as set forth in the claim". For example, *Serkin* does not disclose a "computer-implemented method for dynamically scaling order processing in a securities exchange" that includes:

maintaining, in a memory device, one or more books for a security at the securities exchange, wherein the one or more books each list orders related to the security;  
monitoring, by operation of an application program executing on one or more processors, a volume of orders related to the security received at the securities exchange.

Applicants note that the Examiner has reopened prosecution following a decision by the Board of Appeals affirming the rejection of claims 1-11, but reversing the rejection of claims 12-20. Applicants have amended claim 1 to include elements that bring it in conformance with the scope of independent claims 12 and 17. Accordingly, Applicants submit that the § 102 rejection of claims 1-11 is overcome, for the reasons set forth in the decision by the Board of Appeals.

Applicants further note that in reopening prosecution following the Board's reversal of the rejection as to claims 12-20, the Examiner has added a secondary reference (*Forrester*) and issued a new rejection of claims 12-20 under 35 U.S.C. 103(a). Applicants presume the Examiner would also reject claims 1-11, as amended by this response, using the combination of *Serkin* and *Forrester*. However, the Statement of Common ownership set forth above effectively removes the availability of the *Forrester* under 35 U.S.C. § 103(c). Accordingly, Claims 1-11 cannot be rejected

using this combination. Given the extensive and thorough examination history, Applicants submit this application is now in condition for allowance.

Therefore, claims 1-11 are believed to be allowable, and allowance of these claims is respectfully requested.

**Claim Rejections - 35 U.S.C. § 103**

Claims 12-20 rejected under 35 U.S.C. 103(a) as being unpatentable over *Serkin* in view of *Forrester*, U.S. Patent Application Publication 2005/0102676 (see PTO-892, Ref. C). Applicant respectfully traverses this rejection.

As noted above, the Statement of Common Ownership presented in this response removes the availability of the Forrester reference under 35 U.S.C. § 103(C). Accordingly, Applicants believe the rejection of claims 12-20 is overcome without the need for further comment.

**Conclusion**

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. MCCLELLAN, Reg. #44227/

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